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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/303,368 04/30/99 BRIGHT

M BU9-99-021

EXAMINER

TM02/0604

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O CONNOR, G

ART UNIT

PAPER NUMBER

2167

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/303,368Applicant(s)
Bright et al.Examiner
O'ConnorArt Unit
2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on March 14, 2001 (Paper No. 7 - Amendment "A")

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 3-4, 6, 8-9, 11, and 13-24 is/are pending in the application.

4a) Of the above, claim(s) none is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1, 3-4, 6, 8-9, 11, and 13-24 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: ☐ approved ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Art Unit: 2167

DETAILED ACTION

Preliminary Remarks

1. This second Office action has been prepared in response to the amendment and arguments submitted by applicant on March 14, 2001 (Paper No. 7), in response to the first Office action.
2. The amendment of claims 3, 6, 8, and 13 by applicant in Paper No. 7 is hereby acknowledged.
3. The cancellation of claims 2, 5, 7, 10, and 12 by applicant in Paper No. 7 is hereby acknowledged.

Claim Objections

4. Claims 3, 6, and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for containing redundant recitations which fail to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Several of the various limitations comprising "means for" language fail to further limit the subject matter of their respective previous claims because the additional recitations merely comprise inherent elements which would necessarily already be present, as detailed hereinbelow.

Art Unit: 2167

Regarding claim 3, the “order interceptor receiving [...] electronic sales order data” (claim 1, lines 3-4) *cannot* receive the electronic sales order data without *necessarily* (already) having a “means for receiving the electronic sales order data” (claim 3, line 3).

Regarding claim 6, the “workbench receiving electronic sales order data” (claim 4, lines 1-2) *cannot* receive electronic sales order data without *necessarily* (already) having a “means for receiving [...] electronic sales order data” (claim 6, line 3).

Regarding claim 11, the “reject acknowledgment system receiving an indication from the order interceptor that at least a portion of the electronic sales order data has been rejected (claim 9, lines 1-3) *cannot* receive the indication without *necessarily* (already) having a “means for receiving an indication from the order interceptor that at least a portion of the electronic sales order data is rejected” (claim 11, lines 3-4).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 3-4, 6, 8-9, 11, and 13-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Blinn et al. See, in particular, Figures 13 and 15.

Art Unit: 2167

7. Claims 1, 3-4, 6, 8-9, 11, and 13-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Johnson et al.

Response to Arguments

8. Applicant's arguments filed on March 14, 2001 have been fully considered but are not persuasive.

9. In response to the argument that the system is for "pre-processing orders," rather than for "processing orders," the recitation of "pre-processing" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Art Unit: 2167

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "providing good data in the proper format") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For example, claim 1 assumes good data in the proper format, as it merely claims performing an availability check of inventory, before passing the order along to the next step in the claimed order processing system, the same as is done in the applied prior art references.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to the disclosure.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Serial Number: 09/303,368

Page 6

Art Unit: 2167


calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, Jerry O'Connor, whose telephone number is (703) 305-1525.

GJOC



June 1, 2001

 6/4/01
ROBERT P. OLSZEWSKI
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